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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/298,726	04/23/1999	VALTER MADDALON	06023-71(MI/	2377

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AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.
ONE COMMERCE SQUARE, SUITE 2200
2005 MARKET STREET
PHILADELPHIA, PA 19103

EXAMINER

DEXTER, CLARK F

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 11/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/298,726

Applicant(s)
Maddalon

Examiner
Clark F. Dexter

Art Unit
3724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 20, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, and 8 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. The amendment filed August 20, 2002 has been entered. It is noted that in view of the new amendment practice under 37 CFR 1.121 which became mandatory for all amendments on March 1, 2001, and due to the limited amount of examining time per application, if the amendment contains changes to existing language that requires a marked-up version showing those changes, the Examiner is relying upon the marked-up version(s) for examination of the application. It is applicant's responsibility to ensure that the clean version(s) is (are) the same as the marked-up version(s). It is further noted that the clean version(s) is (are) considered to be the Official version(s).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy et al., pn 5,586,479.

Roy et al. discloses a cutting device with almost every structural limitation of the claimed invention including a first pair of rollers (e.g., 56, 62) which are coupled and thus driven together

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by a first motor; a cutting assembly (e.g., 60) which has a cutting width and is driven by a second motor; a third motor (e.g., 84) pivoting one of the cutting assembly and the pair of rollers; a reading system having first (e.g., 58A) and second (e.g., 58B) spaced apart optical sensors, wherein the second ^{sensor} ~~spacer~~ is spaced apart from the first sensor a distance equal to a fraction of the cutting width (e.g., as shown in Figure 3, the sensors are clearly spaced apart by a distance which is less than the distance of the cutting width of the cutting assembly 60); and a microprocessor (e.g., 30) which "recognizes" marks on the work piece; wherein Roy et al. clearly meets the recitation in the last paragraph of claim 1 in that it is able to perform a cutting operation in two mutually orthogonal directions upon rotation of the substrate through 90° without guides for edge registration of the substrate (i.e., if the guide 55 was removed or simply bi-passed, and the work piece was hand-fed into the rollers, the device of Roy et al. is clearly able to perform the recited cutting operation).

Roy et al. lacks the microprocessor having stored therein a preset sequence of marks corresponding to the feature of the boundary marks, specifically the preset sequence of white and black lines oriented at right angles to the work piece feed direction. However, the Examiner takes Official notice that such marking is old and well known in the art for various known benefits including providing automatic triggering of various different operations during a processing of a work piece. Therefore, it would have been obvious to one having ordinary skill in the art to provide markings on a work piece and to program the microprocessor of Roy et al. to read such markings for the various known benefits including that described above.

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It is noted that if it is argued that Roy et al. does not explicitly disclose a first motor and a second motor, the Examiner takes Official notice that such a configuration is old and well known in the art for various known benefits including providing separate control to individual components as desired. Therefore, it would have been obvious to one having ordinary skill in the art to provide a first and second motor for the well known benefits including that described above.

Regarding claim 8, Roy et al. lacks the cutting assembly having first and second parallel spaced apart blades. However, the Examiner takes Official notice that such a cutter configuration is old and well known in the art and provides various well known benefits including facilitating the making of two parallel cuts simultaneously for various well known benefits including cutting strips with parallel borders. Therefore, it would have been obvious to one having ordinary skill in the art to provide first and second parallel spaced apart blades for the well known benefits including that described above.

Response to Arguments

4. Applicant's arguments filed August 20, 2002 have been fully considered but they are not persuasive.

Regarding applicant's discussion of the telephone interview (see paper no. 21) on page 3 of the amendment, it is respectfully noted that the version of claim 1 proposed for the interview

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(which is attached to the interview summary in the file wrapper) is not the same as the version of claim 1 submitted in the present amendment.

In the second paragraph on page 6 of the amendment, applicant argues that “Roy et al. does not disclose first and second spaced apart optical sensors, the second sensor spaced from the first sensor a distance equal to a fraction of the cutting width.” The Examiner respectfully disagrees. As shown in Figure 3 of Roy et al., the optical sensors 58A, 58B are spaced apart a distance which is clearly less than the distance of the cutting width, particularly since it is clear that the entire width of the web is cut, and each of the sensors is clearly located at a position that is a substantial distance inside the respective edge of the web.

Further in the second paragraph on page 6 of the amendment, applicant argues that “Roy et al., does not disclose a cutting apparatus that is able to perform the cutting of a various size substrates in two mutually orthogonal directions upon rotation of the substrate (1) through 90° without guides for edge registration of the substrate.” The Examiner respectfully disagrees. First, there is nothing in the subject limitation of claim 1 regarding “various size substrates.” Second, it is respectfully submitted that the cutting device of Roy et al. is clearly able to perform cutting in two mutually orthogonal directions upon rotation of the work piece through 90° without guides for edge registration of the substrate. In other words, the operation of the components (e.g., 56, 60, 62) of the cutting device does not rely on the presence of the guide (54, 55), and thus the cutting device is clearly able to perform the recited cutting operation. For example, there is nothing disclosed which would prevent the work piece from being hand fed

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into the rollers 56, hand-received from the rollers 62 after a first cutting operation, and then re-fed into the rollers 56 in an orthogonal direction to perform a second cutting operation.

It is respectfully submitted that for at least these reasons, the prior art rejection must be maintained.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404. The examiner's typical work schedule is Monday, Tuesday, Thursday and Friday, and he can be reached during normal business hours on these days.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Allan Shoap, can be reached at (703)308-1082.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3590; informal/draft papers - (703)305-9835.

A handwritten signature in black ink, appearing to read 'Clark F. Dexter', is positioned above the printed name.

Clark F. Dexter
Primary Examiner
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cfd
November 15, 2002